

### **REMARKS**

Applicant has amended claims 1, 4 and 11.

Claims 1, 2, 7, 11 and 12 have been rejected under 35 USC 102(b) as anticipated by U.S. Patent No. 5,889,596 (Yaguchi). Applicant respectfully traverses this rejection.

Claim 1 as amended recites a controller that controls the image data processor, the storage medium and the compressor. In the claimed apparatus, after the compressed image data corresponding to a page of the document is stored in the storage medium, the controller determines whether the storage medium can store further image data corresponding to a page of the document given for the next image processing. When the storage medium cannot store further, the controller changes the processing applied by the image data processor and the compression rate applied by the compressor to the processed image data so that image data corresponding to all pages of the document can be stored in the storage medium. This amendment finds support, for example, at page 16, line 27 - page 17, line 10, of the specification and FIG. 3 of the application. The method to adjust the compression rate and related processing parameters so as to store the entire image data of the document is described extensively at pages 13-16 of the specification. In short, when the claimed controller finds that image data corresponding to a given page of the document cannot be stored in the storage medium, it calculates the compression rate and the related processing parameters in order to store the image data of the whole document and not just to store the image data of the given page.

The Examiner contends that Yaguchi's CPU performs the functions of the claimed controller. Applicant respectfully disagrees. Yaguchi's CPU compares compressed image data of one document sheet to the remaining capacity of Yaguchi's memory unit 44, which the Examiner equates to the claimed storage medium. If it finds that the compressed image data of the document sheet is larger than the remaining capacity of Yaguchi's memory cell 44, Yaguchi's CPU just "waits until the remaining capacity of the memory unit 44 exceeds the compressed data

amount,” and when it does the image data is compressed again and stored in the memory cell, as explained at column 7, lines 42-51, of Yaguchi and pointed out properly by the Examiner. However, Yaguchi does not state what CPU does while it is waiting. Specifically, it does not say that the controller changes the processing applied by the image data processor and the compression rate applied by the compressor to the processed image data so that image data corresponding to all pages of the document can be stored in the storage medium, as claimed. The lack of a teaching against the invention is not a teaching to carry out the invention, yet that is how the Examiner seems to be reading Yaguchi.

Yaguchi does not teach or suggest the controller of claim 1. Claim 11 recites the functions of the controller of claim 1 in a method claim format. Thus, the rejection of claims 1, 2, 7, 11 and 12 under 35 USC 102(b) on Yaguchi should be withdrawn.

Claims 1, 2, 4-6, 11 and 12 have been rejected under 35 USC 103(a) as unpatentable over U.S. Patent No. 6,181,435 (Onodera) in view of Yaguchi. The Examiner admits that Onodera does not teach or suggest the claimed process change to store image data corresponding to all pages of the document in the storage medium when it is determined that the storage medium cannot store further image data corresponding to another page of the document. See page 6 of the Action. For this teaching, the Examiner relies on the same portion of Yaguchi as he relies in the anticipation rejection. However, Yaguchi does not teach or suggest the claimed change in the processing and the compression rate to store image data corresponding to all pages of the document, as explained above, and Onodera does not teach this change either, as the Examiner admits. Thus, the rejection of claims 1, 2, 4-6, 11 and 12 under 35 USC 103(a) over Onodera and Yaguchi should be withdrawn.

The remaining rejections rely on Yaguchi for the teachings of the claimed controller and thus should be withdrawn as well because Yaguchi does not provide the teachings for which it is cited.


In light of the above, a Notice of Allowance is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, referencing Docket No. 325772023100.

Respectfully submitted,

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